

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DON EVERETT BRANCH and BERNARD RAYMOND PIERRE

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Appeal No. 1999-2163  
Application 08/950,524

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ON BRIEF

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Before PAK, WARREN, and WALTZ, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on an appeal from the examiner's final rejection of claims 1, 5 through 11, and 14 through 17, which are the only claims remaining in this application (see the Brief, pages 2-3). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a method and apparatus for coating sheets by formation of a pseudo-web of partially overlapped sheets from a primary sheet source, periodically interjecting an insert sheet into the pseudo-web

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from a secondary sheet source to form a continuous pseudo-web of overlapped sheets having a consistent relative overlapped orientation, and then individually applying a coating material to at least one major surface of each sheet in the overlapped sequence of sheets (Brief, page 3). A copy of illustrative independent claim 1 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Pulskamp	5,009,408	Apr. 23, 1991
Ritter	5,487,780	Jan. 30, 1996

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ritter in view of Pulskamp (Answer, page 3). We reverse the examiner's rejection for the reasons stated in the Brief and the reasons set forth below.

#### **OPINION**

The examiner finds that Ritter teaches a method and apparatus for applying a coating to overlapped sheets, where the overlapped sheets are conveyed through two coating rollers that simultaneously apply a water-based coating to both surfaces of the sheets at the same point on the surface (Answer, page 3). The examiner further finds that Ritter teaches that both surfaces of the sheets are then dried simultaneously, with subsequent

coating of adhesive applied to one surface of the sheet (*id.*). The examiner applies Pulskamp as evidence that it was conventional in this art to insert separating sheets into conveyed overlapping sheets from a second sheet feeder, without disrupting the flow of the overlapped sheet stream (Answer, page 4). From these findings, the examiner concludes that it would have been obvious to modify the process and apparatus of Ritter by adding the means for inserting the separating sheets from a second sheet feeder into the overlapped sheets as taught by Pulskamp (*id.*). The examiner recognizes that the combination of Ritter and Pulskamp does not teach "separating the overlapped sheets prior to coating and then overlapping again after coating." *Id.* However, it is the "examiner's position" that one of ordinary skill in the art "would perform the steps of overlapping and coating in a sequence consistent with the desired product and would transport the sheets to the coater in any desired fashion." *Id.*

As correctly argued by appellants, the proposed combination of Ritter and Pulskamp by the examiner would still not result in the claimed invention (Brief, page 5). Ritter teaches a sheet inserting station **5** downstream of all coating operations (see

Figure 1 and col. 8, ll. 9-36). Similarly, Pulskamp does not teach any coating operations after the insertion of the insert sheet (see Figure 3 and col. 5, l. 13-col. 6, l. 39). Thus, assuming *arguendo* that it would have been obvious to insert the insertion means of Pulskamp into the process and apparatus of Ritter, one of ordinary skill in this art would have inserted such means in the same location as the sheet inserting station of Ritter, i.e., downstream of any coating operations. The subject matter recited in claim 1 on appeal requires that the inserting operation be located *upstream* from at least one coating operation (see claim 1, steps (b) and (c), and the Brief, page 5).

The examiner has not met the initial burden of proof in establishing a *prima facie* case of obviousness by showing any convincing suggestion, motivation or reasoning why one of ordinary skill in this art would have moved the location of the inserting station and coating operations. The "examiner's position" that one of ordinary skill in this art would perform the steps of overlapping and coating in a sequence consistent with the "desired product" pertains to the main difference over the applied prior art but the examiner has failed to support this "position" by any factual basis or convincing reasoning. See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir.

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2002) ("This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.").

For the foregoing reasons and those set forth in the Brief, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence. Accordingly, we cannot sustain the examiner's rejection of the claims on appeal.

The decision of the examiner is reversed.

REVERSED

CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

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APPENDIX

1. A method for producing coated sheets, comprising:
  - (a) sequentially feeding sheets having first and second major surfaces from a first stack onto a sheet path and continuing to convey the sheets along the sheet path in a machine direction;
  - (b) inserting at least one sheet having first and second major surfaces from a second stack into the sheets being conveyed along the sheet path to form a sequence of sheets arranged in end-to-end overlapping relationship to each other with the entire sequence of sheets configured and arranged with either (i) a trailing edge of each sheet positioned over a leading edge of a subsequent sheet, or (ii) a trailing edge of each sheet positioned under a leading edge of a subsequent sheet; and
  - (c) individually applying coating material to at least one major surface of each sheet in the overlapped sequence of sheets as the sheets continue to be conveyed along the sheet path so as to form coated sheets.